

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trad mark Offic**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*MV*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/325,278 10/26/94 BJORCK

L 216764

HM22/1220

EXAMINER

KARL R. HERMANS  
SEED AND BERRY  
701 FIFTH AVENUE  
SEATTLE WA 98104-7092

MINNIFIELD, N

ART UNIT

PAPER NUMBER

1645

27

DATE MAILED:

12/20/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 08/325,278	Applicant(s) BJORCK ET AL
Examiner N. M. Minnifi Id	Group Art Unit 1645



Responsive to communication(s) filed on Oct 12, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 14-20 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 Claim(s) \_\_\_\_\_ is/are allowed.  
 Claim(s) 14-20 is/are rejected.  
 Claim(s) \_\_\_\_\_ is/are objected to.  
 Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
 The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
 The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.  
 The specification is objected to by the Examiner.  
 The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
 All  Some\*  None of the CERTIFIED copies of the priority documents have been  
 received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_.  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892  
 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
 Interview Summary, PTO-413 8/17/99  
 Notice of Draftsperson's Patent Drawing Review, PTO-948  
 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1645

**DETAILED ACTION**

*Response to Amendment*

1. Applicants' amendment filed October 12, 1999 is acknowledged and has been entered. Claim 14 has been amended. Claims 14-20 are now pending in the present application. All rejections have been withdrawn, in view of Applicants' amendment, with the exception of those discussed below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Applicants' amendment was received and entered as Paper No. 16. However, the amendment to page 5, line 3 was not entered since it is not clear where the phrase "SUMMARY OF THE INVENTION" is to be entered. Additionally, the amendment to page 5, line 26 and page 9, lines 15 and 16 was not entered since the phrase as set forth in applicants amendment were not present on the lines indicated by applicants. Furthermore, the amendment requesting moving the section to page 5, line 21 was not entered as requested. The Examiner requests applicants provide a substitute specification incorporating the amendments as set forth above.

Art Unit: 1645

*As per 10/12/99 Amendment Applicants have indicated that a substitute specification will be submitted in due course.*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14 and 18-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 4,876,194 for the reason set forth in the last Office Action.

Art Unit: 1645

Applicants argue the rejection should be withdrawn in view that claims 1-14 of U.S. Patent No. 4,876,194 does not teach the sequence. Applicants' arguments are not sufficient to obviate the rejection. It is reasonable to conclude protein L as set forth in the issued patent is the same, or in the alternative an obvious or analogous variant of protein consisting of SEQ ID No. 1 as recited in the instant application since they have the same properties (useful as kit, useful as pharmaceutical composition, bind light chains of immunoglobulins, and from *P. magnus* strain 312). Mere discovery that claimed composition possesses property not disclosed for prior art does not *alone* defeat prima facie case of obviousness and it is *not* necessary in order to establish prima facie case, to show both structural similarity between claimed and prior art compound *and* suggestion in, or expectation from, prior art that claimed compound will have same or similar utility as one newly discovered by applicant. See In re Dillon, 16 USPQ2d 1897 (Fed. Cir. 1990).

For the reasons set forth above and in the last Office Action said rejection is maintained.

Claims 15-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 4,876,194 in view of Guss et al. (WO 87/05361)(Art Cited by Applicants in the IDS) and Kastern et al. (1990) (Infection and Immunity

Art Unit: 1645

58(5):1217-22 5/90) (Art Cited by Applicants in the IDS) for the reason set forth in the last Office action.

Applicants' argument is set forth above. For the reasons set forth above and in the last Office Action said rejection is maintained.

Applicant's arguments filed October 12, 1999 have been fully considered but they are not persuasive. Applicants have asserted that obtaining the sequence of the L protein and identification of particular domains that bind immunoglobulin light chain is unusually difficult. However, Applicants have not set forth any evidence of record to support such an assertion. The rejection is maintained.

5. Claims 14 and 18-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Kastern et al. 1992 (J. Biol. Chemistry 267(18):12820-25 1992 (Art Cited by Applicants in the IDS) for the reason set forth in the last Office action.

Applicants argue the rejection should be withdrawn when a declaration is prepared stating the work of Kastern et al. Is that of the named inventors. Until applicants provide a proper declaration said rejection is maintained for the reasons set forth in the last Office Action. This rejection is maintained for the reasons of record.

Applicant's arguments filed October 12, 1999 have been fully considered but they are not persuasive. Applicants have indicated a declaration asserting that Kastern et al is not citeable against the present invention because it is the work of the inventors (declaration under 37 C.F.R. 1.132) will be submitted in due course.

Art Unit: 1645

The rejection remains until such declaration has been formally made of record in this application file.

6. Claims 14 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 255 497 (Art Cited by Applicants in the IDS) or US Patent No. 4,876,194 ('194) (Art Cited by Applicants in the IDS).

The teachings of both references have been set forth in previous Office Actions, see paper number 14. The references teach the protein L and that the protein binds the light chains of immunoglobulins as claimed by Applicants except for the sequence. However, the mere discovery of a claimed sequence does not distinguish over the prior art if the prior art disclose other characteristics of the claimed invention. It is noted that the proteins of the cited prior art references were not characterized by the references as having a specific amino acid sequences. However, the mere discovery of an amino acid sequence, molecular weight or other characterizing features of a protein, which protein is taught by the prior art, imparts neither novelty nor unobviousness to the protein. Further, given that the protein(s) was known in the prior art, one of ordinary skill in the art would have been motivated to identify the amino acid sequence, molecular weight and whether or not the protein is glycosylated since proteins are routinely characterized in this manner. Therefore, the proteins of the reference appear to be consistent with those claimed with the various identifying characteristics

Art Unit: 1645

inherent in them. Since the Office does not have the facilities for examining and comparing applicants' protein with the protein of the prior art, the burden is on applicant to show a novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the protein of the prior art does not possess the same material structural and functional characteristics of the claimed protein). See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

Since the Patent Office does not have the facilities for examining and comparing applicants' proteins with the proteins of the prior art reference, the burden is upon applicants to show a distinction between the material structural and functional characteristics of the claimed proteins and the proteins of the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

Applicants have asserted that it was unusually difficult to obtain the amino acid sequence. However, such assertions should be made in the form of a declaration with references to support this assertion of unusual difficulty.

7. No claims are allowed.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 1645

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MEP. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is (703) 305-3394. The examiner can normally be reached on Monday-Thursday from 7:00 AM-4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D., can be reached on (703) 308-3995. The fax phone number for this Group is (703) 308-4556.

Art Unit: 1645

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

N. M. Minnifield

December 12, 1999

  
NITA MINNIFIELD  
PRIMARY EXAMINER